

REMARKS

Applicant respectfully requests reconsideration and allowance in view of the foregoing amendments and following remarks. In the Office Action, mailed June 9, 2003, the Examiner rejected claims 1-40. By this amendment, previously withdrawn claims 41-68 have been canceled and new claims 69-71 have been added. Following entry of these amendments, claims 1-40 and 69-71 will be pending in the application.

Claim Rejections under 35 U.S.C. §102(b)

In the Office Action, the Examiner rejected claims 1, 11-21 and 31-40 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,304,795 to Saito et al. ("Saito '375"). Applicant respectfully traverses the rejections of claims 1, 11-21 and 31-40.

An anticipation rejection is proper when a patent applicant has claimed an invention that "was patented ... in this or a foreign country ... more than one year one year prior to the date of the application for patent in the United States." 35 U.S.C. §102(b). A claim is anticipated under 35 U.S.C. §102(b) "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (emphasis in original), *cert. denied*, 488 U.S. 892 (1988).

For at least the reasons stated below, Applicant asserts that Saito fails to expressly or inherently describe each and every element of the invention claimed by Applicant and, therefore, that Applicant's rejected claims 1, 11-21 and 31-40 are patentably distinct from Saito.

Both of the rejected independent claims, 1 and 21, and the rejected claims dependent thereon, 11-20 and 32-40, respectively, are directed to an apparatus or method that senses pressure. Independent apparatus claim 1 recites a sensor disposed on a support structure, with the sensor including a ferromagnetic biasing layer, a nonmagnetic conducting layer, and a magnetoresistive layer that has non-zero magnetostriction that will change upon the application of pressure. Independent claim 21 recites an array of such sensors.

Both of independent claims 1 and 21 therefore recite an apparatus including a magnetoresistive sensor that contains the recited biasing, nonmagnetic conducting, and magnetoresistive layers, that further has non-zero magnetostriction in order to sense pressure.

In contrast, and contrary to the Examiner's assertion, Saito '375 is not directed to a magnetoresistive sensor that senses pressure, such as, for example, a fingerprint depression. Rather, Saito '375 is directed to a conventional magnetoresistive sensor that senses magnetic field. For example, in the "Field of the Invention" discussion at column 1, lines 7-10, the Saito '375 invention is stated as relating to "a magnetoresistance effect element and a magnetoresistance effect sensor used in a magnetic field sensor, a magnetic head, and the like." (emphasis added). Further, in the "Summary of the Invention" discussion at column 4, lines 35-36, the Saito '375 invention is stated as being "applied to a magnetic sensor, e.g., a magnetic head." (emphasis added). In fact, a simple text search of Saito '375, reveals several references where the Saito '375 being used in a magnetic field, and none where Saito '375 is used to sense pressure. Thus, Applicant respectfully asserts that the Examiner's reliance on Saito '375 is misplaced.

Accordingly, for at least the above reason, Applicant submits that each of independent claims 1 and 21, as well as the claims dependent thereon, 11-20 and 32-40, respectively, are allowable over the art of record.

Claim Rejections under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 2-10 and 22-30 under 35 U.S.C. §103(a) as being unpatentable over Saito '375 in view of European Patent Application No. EP 0690296 to Saitou et al. ("Saitou '296). Applicant respectfully traverses the rejections of claims 2-10 and 22-30 and reminds the Examiner of the following standards for a proper §103(a) rejection.

A §103(a), or obviousness, rejection is proper only when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which the subject matter pertains." 35 U.S.C. §103(a). The Examiner must make out a *prima facie* case for obviousness. The mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The *en banc* Federal Circuit has held that "structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness." *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1901 (CAFC 1990). The underlying inquiries into the validity of an obvious rejection are: "(1) the scope and content of the

prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.” *In re Dembiczak*, 175 F.3d 994, 998, (Fed. Cir. 1999).

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Likewise, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For at least the reasons stated below and taking into consideration the standards for obviousness presented above, Applicant asserts that one of ordinary skill in the art would not have considered Applicant’s invention obvious at the time of invention and, therefore, that Applicant’s rejected claims 2-10 and 22-30 are not obvious over the prior art of record.

Dependent claims 2-10 and 22-30 ultimately depend from independent claims 1 and 21, respectively. The allowability of dependent claims 2-10 and 22-30 thus follows from the allowability of independent claims 1 and 21, respectively; as such, dependent claims 2-10 and 22-30 are allowable over the art of record.

Furthermore, while Applicant asserts that Saito ‘375 is not relevant to the present invention, if the Examiner maintains a contrary position, Applicant furthermore respectfully asserts that Saitou ‘296 is also not relevant and that one of ordinary skill in the art would not have been motivated to combine Satio ‘375 with Saitou ‘296.

In particular, Saitou ‘296 fails to disclose or suggest the deformable beam or structure that is capable of supporting the plurality of layers as required by Applicant’s claimed invention. Rather, Saitou ‘296 merely discloses a ceramic substrate. Additionally, a combination of these references is inappropriate because the function of sensing magnetic field in Satio ‘375 would necessarily be destroyed if modified as in Saitou ‘296.

And even further, there is no teaching in any of the references, including Gurney ‘617, that teaches how to obtain a sensor with the recited layers to sense pressure disposed on a deformable beam as in Applicant’s invention.

Therefore, for at least these reasons, Applicant respectfully submits that dependent claims 2-10 and 22-30 are in a condition for allowance, and respectfully request such a Notice to that effect.

New Claims

By this response, Applicant adds new claims 69-71, which were previously submitted as claims 62, 63 and 66, respectively. The previously submitted claims (as with new claims 69-71) depended from claims 1 and 21, but were incorrectly lumped into Group III of the restriction requirement and subsequently cancelled when Applicant elected Group I for prosecution in the present application.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

CHARGE STATEMENT: The Commissioner is hereby authorized to charge fees that may be required relative to this application, or credit any overpayment, to our Deposit Acct. 03-3975, Order No. 061450-0261860 (FID-001).

Respectfully submitted,
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